

REMARKS

Reconsideration of the above-identified patent application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-38 are in this case. Claims 1, 12 and 13 have been rejected under § 102(b). Claims 1, 3-11 and 14-37 have been rejected under § 102(e). Claim 2 has been rejected under § 103(a). Claim 38 has been allowed. Claims 2, 4, 7, 8, 15-18, 25 and 35-37 have been canceled. Independent claims 1 and 14 and dependent claims 19, 24 and 26 have been amended. New claims 39-45 have been added.

The claims before the Examiner are directed toward a fuel cell electrode and toward a fuel cell. The fuel cell electrode includes a catalytic layer sandwiched between two diffusion control layers. The fuel cell includes a fuel composition within a fuel chamber, an anode with a catalytic layer and with a diffusion control layer between the catalytic layer and the fuel chamber and in contact with the catalytic layer, and a cathode. The fuel cell also includes a liquid, gel or suspension electrolyte configured to transport ions from the anode to the cathode. Alternatively, the fuel composition includes both a fuel and an electrolyte.

§ 102(e) Rejections – Finkelshtain et al. ‘877

The Examiner has rejected claims 1, 3-6, 9 and 14-37 under § 102(e) as being anticipated by Finkelshtain et al., US Patent No. 6,554,877 (henceforth, “Finkelshtain et al. ‘877”). The Examiner’s rejection is respectfully traversed.

Attached please find a declaration under 37 CFR 1.132 showing that the above-identified patent application and Finkelshtain et al. ‘877 always have been commonly owned. It therefore is improper for the Examiner to cite Finkelshtain et al. ‘877 against the claims of the above-identified patent application.

§ 102(e) Rejections – Finkelshtain et al. ‘602

The Examiner has rejected claims 1 and 3-8 under § 102(e) as being anticipated by Finkelshtain et al., US Published Patent Application No. 2002/0076602 (henceforth, “Finkelshtain et al. ‘602”). The Examiner’s rejection is respectfully traversed.

Attached please find a declaration under 37 CFR 1.132 showing that the above-identified patent application and Finkelshtain et al. ‘602 always have been commonly owned. It therefore is improper for the Examiner to cite Finkelshtain et al. ‘602 against the claims of the above-identified patent application.

§ 102(e) Rejections – Inoue ‘051

The Examiner has rejected claims 1, 3, 5, 6, 9-11 and 14-17 under § 102(e) as being anticipated by Inoue, US Patent No. 6,489,051 (henceforth, “Inoue ‘051”). The Examiner’s rejection is respectfully traversed.

Claims 15-17 have been canceled, thereby rendering moot the Examiner’s rejection of these claims.

Applicant believes claims 1 and 14 to be allowable over Inoue ‘051. Nevertheless, in order to expedite the prosecution, Applicant has chosen to render claims 1 and 14 allowable by amending claim 1 to include the limitations of claim 2 and by amending claim 14 to include the limitations of claim 18. Correspondingly, claims 2 and 18 have been canceled and claims 19 and 24 have been amended to depend from claim 14. The only prior art cited by the Examiner against claims 2 and 18 was Finkelshtain et al. ‘877. As discussed above, the above-identified patent application and Finkelshtain et al. ‘877 always have been commonly owned, so that it was improper for the Examiner to cite Finkelshtain et al. ‘877 against claims 2 and 18.

With claim 1 allowable in its present form, it follows that claims 3, 5, 6, and 9-11, that depend from claim 1, also is allowable.

§ 102(b) Rejections – Allen et al. ‘206

The Examiner has rejected claims 1 and 13 under § 102(b) as being anticipated by Allen et al., US Patent No. 5,300,206. The Examiner’s rejection is respectfully traversed.

As discussed above, claim 1 has been placed in condition for allowance by the inclusion therein of the limitations of claim 2. It follows that claim 13, that depends from claim 1, also is allowable.

§ 102(b) Rejections – DE 19544323

The Examiner has rejected claims 1 and 12 under § 102(b) as being anticipated by DE 19544323. The Examiner’s rejection is respectfully traversed.

As discussed above, claim 1 has been placed in condition for allowance by the inclusion therein of the limitations of claim 2. It follows that claim 12, that depends from claim 1, also is allowable.

§ 103(a) Rejections – Finkelshtain et al. ‘877

The Examiner has rejected claim 2 under § 103(a) as being unpatentable over Finkelshtain et al. ‘877. The Examiner’s rejection is respectfully traversed.

Attached please find a declaration under 37 CFR 1.132 showing that the above-identified patent application and Finkelshtain et al. ‘877 always have been commonly owned. It therefore is improper for the Examiner to cite Finkelshtain et al. ‘877 against the claims of the above-identified patent application.

Other Amendments to the Claims

Finkelshtain et al. '877 and Finkelshtain et al. '602 were the only prior art cited by the Examiner against dependent claims 4, 7, 8, 25, 35, 36 and 37. As discussed above, the above-identified patent application, Finkelshtain et al. '877 and Finkelshtain et al. '602 always have been commonly owned, so that it was improper for the Examiner to cite Finkelshtain et al. '877 and Finkelshtain et al. '602 against the claims of the above-identified patent application. Therefore, claims 4, 7, 8, 25, 35, 36 and 37 have been rewritten in independent form, as new claims 39-45. Correspondingly, claims 4, 7, 8, 25, 35, 36 and 37 have been canceled, and claim 6 has been amended to depend from claim 42.

Amendments to the Specification

Since the above-identified patent application was filed, US Patent Application No. 09/752,551 has issued as US Patent No. 6,554,877. Therefore, the references to US Patent Application No. 09/752,551 in the paragraph beginning on page 6 line 3 have been replaced with references to US Patent No. 6,554,877.

An inadvertent spelling error ("are" instead of "art") in the paragraph beginning on page 8 line 7 has been corrected.

No new matter has been added.

In view of the above amendments and remarks it is respectfully submitted that independent claims 1, 14 and 38-45, and hence dependent claims 3, 5, 6, 9-13, 19-24 and 26-34 are in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,


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